

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-33 are pending in this application, Claims 1, 7, 11, 17, 21, 27, and 31 having been currently amended. Support for amended Claims 1, 7, 11, 17, 21, 27, and 31 can be found, for example, in the original claims, drawings, and specification as originally filed.¹ No new matter has been added.

In the outstanding Office Action, Claims 1 and 32 were rejected under 35 U.S.C. § 101; Claims 1 and 32 were rejected under 35 U.S.C. § 112, second paragraph; Claims 1, 11, and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by Yuka. (JP08-039894); Claims 1, 11 and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by Hirohiko (JP11-119609); Claims 1-3, 5, 6, 11-13, 15, 16, 21-23, 25, 26, and 31 were rejected under 35 U.S.C. § 102(b) as anticipated by Goldsmith et al. (U.S. Patent No. 5,010,551; hereinafter “Goldsmith”); and Claims 4, 7-10, 14, 17-20, 24, and 27-30 were rejected under 35 U.S.C. § 103(a) as unpatentable over Goldsmith in view of Machida et al. (U.S. Patent Publication No. 2001/0026290; hereinafter “Machida”).

Applicant acknowledges with appreciation the courtesy of Examiner Peche in discussing this case with Applicants’ representative on May 18, 2009, during which time the IDS of July 19, 2004 was discussed. The outstanding Office Action stated that JP 8-39894 was not marked as having been considered because a statement of relevancy of the reference has not been filed. Applicant’s representative noted that an English translation of the Abstract of this reference was filed on July 19, 2004, as indicated in PAIR. The Examiner indicated that this reference will be marked as having been considered in the next Office Action.

¹ See original Claims 7, 17, and 27; and page 23, line 5 to page 24, line 21 of the specification.

In response the rejection of Claims 1 and 32 under 35 U.S.C. § 101, Applicant respectfully submits that these claims are not directed towards two statutory categories of invention, rather Claims 1 and 31 are directed to a method which is tied to a particular device, as required by the recent Federal Circuit case *In re Bilski*, which set forth a new test for determining whether or not a method claim recites statutory subject matter. Under *In re Bilski*, a claim recites statutory subject matter if it is tied to a particular machine or apparatus, or transforms an article into a different state or thing.

Accordingly, Applicant respectfully requests that the rejection of Claims 1 and 32 under 35 U.S.C. § 101 be withdrawn.

In regard to the rejection to Claims 1 and 32 under 35 U.S.C. § 112, second paragraph, Claims 1 and 32 are believed to recite statutory subject matter as described above, and thus the rejection under 35 U.S.C. § 112 is believed to be overcome by virtue of the remarks discussed above with respect to the rejection under 35 U.S.C. § 101.

Accordingly, Applicant respectfully request that the rejection of Claims 1 and 32 under 35 U.S.C. § 112, second paragraph be withdrawn.

In response to the rejections under 35 U.S.C. §§ 102(b) and 103(a), Applicant has amended Claim 1 to recite features formerly of Claim 7. Applicant respectfully submits that amended independent Claim 1 recites novel features clearly not taught or rendered obvious by the applied references.

Amended independent Claim 1 is directed to a guidance output method including, *inter alia*:

...displaying, in response to a display instruction, guidance information indicated by a guidance part on a display part that is provided on the electronic apparatus, and ***the guidance information is displayed on the display part after subjecting the guidance information to a color conversion process for facilitating color discrimination in response to a conversion instruction,***

wherein said guidance part is provided within the electronic apparatus at a location corresponding to an apparatus part, that is provided within the electronic apparatus, and to which the guidance information is related.

Amended independent Claims 11 and 31 recites substantially similar features as independent Claim 1. Thus, the arguments presented below with respect to independent Claim 1 are also applicable to independent Claims 11 and 31.

Page 14 of the outstanding Office Action, in the rejection of Claim 7, asserts that paragraphs [0156], [0157], and [0162] of Machida describes that the “displaying step displays the guidance information on the display part after subjecting the guidance information to a color conversion process for facilitating color discrimination and/or an enlarging conversion process in response to conversion instruction.” However, Applicant respectfully submits that Machida fails to teach or suggest that “the guidance information is displayed on the display part after subjecting the guidance information to a color conversion process for facilitating color discrimination in response to a conversion instruction,” as recited in amended Claim 1.

Paragraphs [0156], [0157], and [0162] of Machida merely describes a size setting menu, a magnification setting menu, and a "zoom" function, and do not describe, among other things, displaying the guidance information on the display part after subjecting the guidance information to a color conversion process for facilitating color discrimination.

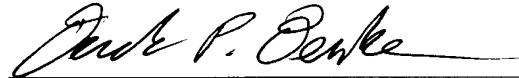
Accordingly, Applicant respectfully submits that amended independent Claims 1, 11, 21 and 31 (and all claims depending thereon) patentably distinguish over Machida. Further, Applicant respectfully submits that Yuka, Hirohiko, and Goldsmith fail to cure any of the above-noted deficiencies of Machida.

Thus, Applicant respectfully requests that the rejections under 35 U.S.C. §§ 102(b) and 103(a) be withdrawn.

Consequently, in view of the present amendment, and in light of the above discussion, the pending claims as presented herewith are believed to be in condition for formal allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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